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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/754,812

01/09/2004

Peter S. Schulte

92/D03-016A

1565

34431

7590

09/02/2008

HANLEY, FLIGHT & ZIMMERMAN, LLC

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SUITE 2100

CHICAGO, IL 60606

EXAMINER

STRIMBU, GREGORY J

ART UNIT

PAPER NUMBER

3634

MAIL DATE

DELIVERY MODE

09/02/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/754,812

Applicant(s)

SCHULTE ET AL.

Examiner

Gregory J. Strimbu

Art Unit

3634

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/4/08 + 3/6/08.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31, 37-45 and 48-64 is/are pending in the application.
- 4a) Of the above claim(s) 43 and 55 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31, 37-42, 44, 45, 48-54, 56-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Election/Restrictions

Applicant's election with traverse of species I in the reply filed on April 17, 2006 is acknowledged. The traversal is on the ground(s) that the examiner has failed to provide any reasoning as to why each of the alleged species is independent or distinct, the examiner has failed to allege that it would be a serious burden on the examiner to consider all of the different species, and maintaining the restriction requirement is a serious burden on the applicant. This is not found persuasive because the examiner has provided reasoning as to why each of the species is independent and distinct. See page 2 of the Office action mailed March 17, 2006. Because the applicant has failed to address the examiner's reasoning why each of the species is patentably distinct, the applicant's comments in the reply of April 17, 2006 are not persuasive. Additionally, withdrawal of the restriction requirement would create a serious burden on the examiner because additional classes/subclasses would need to be searched in order to properly examine all of the patentably distinct inventions. Finally, maintaining the restriction requirement does not necessarily create an additional burden on the applicant. If a generic claim is found to be allowable, all of the applicant's patentably distinct inventions would be included in one patent. The requirement is still deemed proper and is therefore made FINAL.

Claims 43 and 55 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on April 17, 2006.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 31, 37 and 44 are rejected under 35 U.S.C. 102(e) as being anticipated by Delgado et al. (US 20050076570). Delgado discloses a door 10 for at least partially covering a doorway and movable relative thereto, the doorway being defined by a surrounding structure 20 that includes a wall such that the doorway has a width, the door comprising:

an upper track (not shown, but see paragraph 37, line 5);

a door panel 14 suspended from the upper track and being movable horizontally relative to the doorway along a predetermined normal path;

a lower track 22, 74 (see figures 15 and 16) disposed below the upper track, wherein the lower track is attachable to the surrounding structure such that the lower track is entirely outside the width of the doorway;

a panel retention system 24 adapted to be carried by the door panel, wherein the panel retention system is movably connected to the lower track such that the panel retention system and the lower track provide relative traveling motion therebetween to help guide the door panel along the predetermined normal path; and

a resilient connection 28b provided by at least one of the lower track and the panel retention system, wherein the resilient connection limits movement of the door panel out of the predetermined normal path, wherein the panel retention system remains in contact with the lower track 74 even if the door panel moves out of the predetermined normal path;

wherein the lower track 22 is a stationary bar;

wherein the panel retention system includes the resilient connection.

Claims 57, 58 and 59 are rejected under 35 U.S.C. 102(b) as being anticipated by Delgado et al. Delgado et al. discloses a door 10 for at least partially covering a doorway and movable relative thereto, the doorway being defined by a surrounding structure 20 that includes a wall such that the doorway has a width, the door comprising:

an upper track (not shown, but see paragraph 37, line 5);

a door panel 14 suspended from the upper track and being movable horizontally relative to the doorway along a predetermined normal path;

a lower track 22, 74 (see figures 15 and 16) disposed below the upper track, wherein the lower track 22 is attachable to the surrounding structure 20 such that the lower track 22 is entirely outside the width of the doorway;

a panel retention system 24 adapted to be carried by the door panel 14, wherein the panel retention system is movably connected to the lower track such that the panel

retention system and the lower track provide relative traveling motion therebetween to help guide the door panel along the predetermined normal path; and

a resilient connection 28b provided by at least one of the lower track and the panel retention system, wherein the resilient connection allows the door panel to move out of the predetermined normal path when subjected to an impact force but applies a restorative force to the door panel that has both a horizontal component and a vertical component to return the door panel to the predetermined normal path upon removal of the impact force by virtue of the interaction of the track portion 74 and the retention system 24;

the panel retention system remains in contact with the lower track even if the door panel moves out of the predetermined normal path via the interaction of the track portion 74 and the retention system 24.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 31, 37-42, 44, 45, 48-54 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Delgado et al. in view of Linstadt (1802519). Delgado discloses a door 10 for at least partially covering a doorway and movable relative

thereto, the doorway being defined by a surrounding structure 20 that includes a wall such that the doorway has a width, the door comprising:

- an upper track (not shown, but see paragraph 37, line 5);

- a door panel 14 suspended from the upper track and being movable horizontally relative to the doorway along a predetermined normal path;

- a lower track 22 disposed below the upper track, wherein the lower track is attachable to the surrounding structure such that the lower track is entirely outside the width of the doorway;

- a panel retention system 24 adapted to be carried by the door panel, wherein the panel retention system is movably connected to the lower track such that the panel retention system and the lower track provide relative traveling motion therebetween to help guide the door panel along the predetermined normal path; and

- a resilient connection 28b provided by at least one of the lower track and the panel retention system, wherein the resilient connection limits movement of the door panel out of the predetermined normal path;

the lower track 22 is a stationary bar. It could be argued that Delgado et al. fails to disclose a panel retention system that remains in contact with the lower track even if the door panel moves out of the predetermined normal path.

However, Linstadt discloses a door comprising a panel retention system 12-16 wherein the panel retention system remains in contact with a lower track 8 even if a door panel 3 moves out of a predetermined normal path;

wherein the panel retention system comprises a spring 14 and a track follower 13, wherein the track follower engages the track and the spring is coupled to the track follower to urge the door panel toward the predetermined normal path when the door panel is beyond the predetermined normal path;

wherein the spring is disposed in a tube 15;

a pliable elongate member 12 coupling the spring 14 to the track follower 13;

the pliable elongate member 12 has a length that is adjustable to vary a resiliency of the panel retention system.

It would have been obvious to one of ordinary skill in the art to provide the retention system of Delgado et al. with a spring system, as taught by Linstadt, to enable the door to automatically return to its predetermined normal path when a force has been applied to the door that is not great enough to cause separation of the retention system from the track.

Claims 60-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Delgado et al. as applied to claims 57, 58 and 59 above, and further in view of Linstadt. Linstadt discloses a door comprising a panel retention system comprising a spring 14 and a track follower 13, wherein the track follower engages a lower track 8 and the spring is coupled to the track follower to urge a door panel 3 toward a predetermined normal path when the door panel is out of the predetermined normal path;

wherein the track follower 13 remains in contact with the lower track 8 even when the door panel 3 is out of the predetermined normal path;

wherein the spring is disposed within a tube 15;

an elongate member 12 coupling the spring to the track follower 13.

It would have been obvious to one of ordinary skill in the art to provide the retention system of Delgado et al. with a spring system, as taught by Linstadt, to enable the door to automatically return to its predetermined normal path when a force has been applied to the door that is not great enough to cause separation of the retention system from the track.

Response to Arguments

Applicant's arguments filed March 6, 2008 and June 4, 2008 have been fully considered but they are not persuasive.

Regarding the applicants' argument that Delgado et al. fails to disclose a panel retention system that remains in contact with a lower track even if the door panel moves out of a predetermined path, the examiner respectfully disagrees. As shown in figures 15 and 16 the track 22 includes a track portion 70 which engages the panel retention system 24 when the door panel 14 is out of the predetermined path. Thus, Delgado et al. anticipates the limitations of claim 31.

Regarding the applicants' comments concerning the combination of the teachings of Delgado et al. and Linstadt, the examiner respectfully disagrees. It should first be noted that the examiner is not proposing that the retention system of Delgado et al. be replaced entirely by the retention system of Linstadt. Rather, it is the examiner's position that one with ordinary skill in the art would provide the retention system of

Delgado et al. with the spring return mechanism of Linstadt. With such a hybrid retention system, the door 14 of Delgado et al. would be able to absorb impact forces having a lower magnitude without damaging the door or causing the door to separate from the track. However, if the impact force is great enough, the door 14 of Delgado et al. would separate from the track and, therefore, avoid damaging the door. Accordingly, the applicant's position that Delgado et al. teaches away from a panel retention system that maintains contact with the track is not persuasive.

In response to applicants' arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The applicants' declaration regarding the combination of the teachings of Delgado et al. and Linstadt is not persuasive. First, the declaration is not persuasive for the reasons set forth above. Second, the declaration is not persuasive because the rationale to modify or combine the prior art does not have be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Since the applicant has failed to address the reasoning/rationale supplied by the examiner as to why the modification would have

been obvious, the applicant's arguments are not persuasive. Finally, the office action clearly provides a rational for combining the teachings of Delgado et al. and Linstadt.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Strimbu whose telephone number is 571-272-6836. The examiner can normally be reached on Monday through Friday 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Katherine Mitchell can be reached on 571-272-7069. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gregory J. Strimbu/
Primary Examiner, Art Unit 3634